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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,596	02/27/2002	Dale E. Gulick	2000.051900/TT4033	8995
23720	7590	03/28/2006		
WILLIAMS, MORGAN & AMERSON 10333 RICHMOND, SUITE 1100 HOUSTON, TX 77042			EXAMINER WILLIAMS, JEFFERY L	
			ART UNIT 2137	PAPER NUMBER
DATE MAILED: 03/28/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/084,596

Applicant(s)

GULICK, DALE E.

Examiner

Jeffery Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

This action is in response to the communication filed on 1/11/2006.

All objections and rejections not set forth below have been withdrawn.

***Election/Restrictions***

Claims 1 – 50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/07/2005.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1       **Claims 51, 52, 54 – 57, 59 – 62, 64, and 65 are rejected under 35**  
2       **U.S.C. 102(e) as being anticipated by Flyntz, “Multi-Level Secure Computer With**  
3       **Token-Based Access Control”, U.S. Patent 6,389,542.**  
4

5       Regarding claim 51, Flyntz discloses:  
6       *receiving a request for an authentication, at a microcontroller, requesting*  
7       *security data from a security device; receiving the security data from the security device,*  
8       *at the microcontroller (Flyntz, col. 2, lines 52-56; col. 15, lines 5-20, 33-36, 53-55).*  
9       Flyntz discloses that a user requests authentication by supplying security data to the  
10      microcontroller, which in turn processes such security data to evaluate acceptance.  
11      *evaluating the security data; and approving the authentication if the security data*  
12      *is evaluated as acceptable (Flyntz, col. 10, lines 33-40).*  
13

14      Regarding claim 52, Flyntz discloses:  
15      *disapproving the authentication if the security data is evaluated as unacceptable*  
16      *(Flyntz, col. 2, lines 53-57; col. 10, lines 33-37).*  
17

18      Regarding claim 54, Flyntz discloses:  
19      *wherein requesting security data from a security device comprises requesting the*  
20      *security data from the security device over a direct connection between the security*  
21      *device and the microcontroller; and wherein receiving the security data from the security*  
22      *device, at the microcontroller, comprises receiving the security data from the security*

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1 *device over the direct connection to the microcontroller (Flyntz, fig. 2, elem. 31, 32).*

2 Flyntz discloses a direct connection between the security device and the  
3 microcontroller.  
4

5 Regarding claim 55, Flyntz discloses:

6 *wherein requesting security data from a security device comprises requesting*  
7 *biometric data from a biometric device; wherein receiving the security data from the*  
8 *security device, at the microcontroller, comprises receiving the biometric data from the*  
9 *biometric device, at the microcontroller (Flyntz, col. 2, lines 52-56; col. 15, lines 5-20,*  
10 *33-36, 53-55; col. 6, lines 36-46).*

11 *wherein evaluating the security data comprises evaluating the biometric data;*  
12 *and wherein approving the authentication if the security data is evaluated as acceptable*  
13 *comprises approving the authentication if the biometric data is evaluated as acceptable*  
14 *(Flyntz, col. 2, lines 52-56; col. 15, lines 5-20, 33-36, 53-55; col. 6, lines 36-46; col. 10,*  
15 *lines 33-40).*

16  
17 Regarding claims 56, 57, 59 – 62, 64, and 65, they are the method steps and  
18 method implemented on computer readable medium claims corresponding to the  
19 method claims above, and are rejected for the same reasons.  
20  
21

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 53, 58, and 63 rejected under 35 U.S.C. 103(a) as being unpatentable over Flyntz in view of Angelo, "Method and Apparatus for Allowing Access to Secured computer Resources by Utilizing a Password and an External Encryption Algorithm", U.S. Patent 5,949,882.**

Regarding claim 52, Flyntz discloses a system for providing power to secure system portions. Using such a mode of system management allows the system of Flyntz to provide access to authentication requests only after a positive indication of acceptability has been received (Flyntz, Abstract; col. 1, lines 55-63). Flyntz, however, does not disclose the authentication process as occurring in SMM, or system management mode. Specifically, Flyntz does not disclose *wherein evaluating the security data comprises requesting an indication of acceptability inside SMM*.

Like Flyntz, Angelo discloses a secure power up procedure for providing power to system portions that have been permitted access by authorized users (Angelo, Abstract; col. 6, lines 44-50; col. 11, lines 17-45). Angelo specifically discloses that such a method of system management employs SMM, or system management mode.

1 SMM is advantageously a secure mode of system operation.

2 It would have been obvious to one of ordinary skill in the art to employ the  
3 method of authentication within SMM by Angelo with the system for authentication of  
4 Flyntz. This would have been obvious because one of ordinary skill in the art would  
5 have been motivated to employ methods that are known to be secure.

6  
7 Regarding claims 58 and 63, they are the method steps and method  
8 implemented on computer readable medium claims corresponding to the method claims  
9 52, and are rejected for the same reasons.

10  
11  
12 ***Response to Amendment***  
13

14 The declarations filed on 1/11/2006 under 37 CFR 1.131 has been considered  
15 but is ineffective to overcome the filing date of the Flyntz reference (U.S. Patent  
16 6,389,542).

17  
18 The evidence submitted is insufficient to establish a conception of the invention  
19 prior to the effective date of the Flyntz reference (U.S. Patent 6,389,542). While  
20 conception is the mental part of the inventive act, it must be capable of proof, such as  
21 by demonstrative evidence or by a complete disclosure to another. Conception is more  
22 than a vague idea of how to solve a problem. The requisite means themselves and

1 their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897  
2 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

3 Each exhibit (in this case, Exhibit A) relied upon should be specifically referred to  
4 in the affidavit or declaration, *in terms of what it is relied upon to show*. The declaration  
5 and exhibits must clearly explain which facts or data or data applicant is relying on to  
6 show completion of his or her invention prior to the particular date. In the instant case,  
7 the applicant has failed to show how the declarations and exhibits clearly provide  
8 support for conception of the claimed invention (claims 51 – 65), prior to the filing date of  
9 the reference of Flyntz. The applicant fails to show a correspondence between Exhibit  
10 A and the claimed invention. A declaration by the inventor to the effect that his or her  
11 invention was conceived or reduced to practice prior to the reference date, without a  
12 statement of facts demonstrating the correctness of his conclusion, is insufficient to  
13 satisfy 37 CFR 1.131.

14 The examiner points out that vague and general statements in broad terms about  
15 what the exhibits describe along with a general assertion that the exhibits describe a  
16 reduction to practice “amounts essentially to mere pleading, unsupported by proof or a  
17 showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re  
18 Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear  
19 explanation of the exhibits pointing out exactly what facts are established and relied on  
20 by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920,  
21 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what  
22 they are or when they occurred.”). [see MPEP 715.07]



1  
2 Furthermore, the examiner notes that in determining the sufficiency of a 37 CFR  
3 1.131 affidavit or declaration, *diligence need not be considered unless conception of the*  
4 *invention prior to the effective date is clearly established*, since diligence comes into  
5 question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd.  
6 App. 1958). [See MPEP 715.07(a)].

7 However, for matters of record, the examiner additionally points out that the  
8 evidence submitted is insufficient to establish diligence from a date prior to the date of  
9 reduction to practice of the Flyntz reference to either a constructive reduction to practice  
10 or an actual reduction to practice. It is the responsibility of the applicant to show  
11 evidence of facts establishing diligence.

12 In the instant case, the applicant fails to provide evidence of facts for establishing  
13 diligence during the time period of 96 days (3 months, 5 days), beginning when the  
14 applicant allegedly prepared Exhibit A up to the time when the prior art reference of  
15 Flyntz is filed.

16 Additionally, the examiner finds insufficient the failure of the applicant to provide  
17 evidence of facts for establishing diligence during the time period of 625 days (1 year, 8  
18 months, 15 days), beginning when the applicant's representative allegedly is requested  
19 to prepare a U.S. patent application up to the time when the applicant's representative  
20 allegedly contacts the applicant for the possible submission of the application to the  
21 U.S. Patent Office.

Additionally, the examiner finds insufficient the failure of the applicant to provide evidence of facts for establishing diligence during the time period of 27 days, beginning when the applicant's representative allegedly contacts the applicant for the possible submission of the application to the U.S. Patent Office up to the time when the applicant allegedly signs the application for submission to the U.S. Patent Office.

## Response to Arguments

Applicant's arguments filed 1/11/2006 have been fully considered but they are not persuasive. Applicants arguments are based upon declarations under 37 CFR 1.131 which have been found to be insufficient.

## Conclusion

Claims 51 – 65 are pending.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Angelo et al., "Secure Two-Piece User Authentication in a Computer Network",  
US Patent 5,953,422.

1 Kong, "Method of Detaching a Security Device form a Personal Computer", US  
2 6,243,813.

3 Mooney et al., "Preboot Protection of Unauthorized Use of Programs and Data  
4 with a Card Reader Interface", US Patent 5,327,497.

5  
6  
7 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time  
8 policy as set forth in 37 CFR 1.136(a).

9 A shortened statutory period for reply to this final action is set to expire THREE  
10 MONTHS from the mailing date of this action. In the event a first reply is filed within  
11 TWO MONTHS of the mailing date of this final action and the advisory action is not  
12 mailed until after the end of the THREE-MONTH shortened statutory period, then the  
13 shortened statutory period will expire on the date the advisory action is mailed, and any  
14 extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of  
15 the advisory action. In no event, however, will the statutory period for reply expire later  
16 than SIX MONTHS from the mailing date of this final action.

17 Any inquiry concerning this communication or earlier communications from the  
18 examiner should be directed to Jeffery Williams whose telephone number is (571) 272-  
19 7965. The examiner can normally be reached on 8:30-5:00.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
21 supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffery Williams  
AU: 2137

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER